

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

DEC 9, 97

Paper No. 17
EWH/KRD

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re SunDisk Corporation

Serial No. 74/543,923

Gerald P. Parson of Majestic, Parsons, Sieber & Hsue for
SunDisk Corporation.

Jeffrey D. Frazier, Trademark Examining Attorney, Law Office
104 (Sidney Moskowitz, Managing Attorney).

Before Cissel, Seeherman and Hanak, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

SunDisk Corporation (applicant) seeks registration of
COMPACTFLASH in typed capital letters for "solid state
memory cartridge sold blank or carrying data-compression
software." The intent-to-use application was filed on June
29, 1994. On January 20, 1996 applicant filed an amendment
to allege use stating that the mark was first used anywhere
and in interstate commerce on June 7, 1995.

The Examining Attorney refused registration pursuant to Section 2(e)(1) of the Lanham Trademark Act on the basis that applicant's mark is merely descriptive of applicant's goods.

When the refusal was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant initially requested an oral hearing, but later withdrew said request.

As has been stated repeatedly, "a term is merely descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [or services]." In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) (emphasis added); Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976). Moreover, the immediate idea must be conveyed forthwith with a "degree of particularity." In re TMS Corp. of the Americas, 15 USPQ 57, 59 (TTAB 1978); In re Entenmann's Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd 90-1495 (Fed. Cir. February 13, 1991).

In support of his refusal, the Examining Attorney has made of record definitions of the terms "flash disk" and "flash memory" taken from The Computer Glossary (1995). The first term is defined as "a solid state disk made of flash memory." The term "flash memory" is defined as "a memory chip that holds its content without power." In addition,

the Examining Attorney has made of record an excerpt from The American Heritage Dictionary showing that one of the meanings of the word "compact" is "packed into or arranged within a relatively small space." The Examining Attorney then argues that "the wording 'compact flash' immediately tells prospective purchasers that the applicant's solid state memory cartridges are small in size (i.e., they are compact) and that they employ flash technology." (Examining Attorney's brief page 5).

In addition, the Examining Attorney has made of record an excerpt of one story taken from the NEXIS database which reads, in part, as follows: "Compact flash memory products are expected to grow in demand because of the move to computer miniaturization." (In point of fact, there is no evidence that this excerpt -- taken from the Reuters Financial Report cycle of April 22, 1992 -- ever actually appeared in print form.) Finally, the Examining Attorney has made of record one of applicant's news releases dated March 21, 1996. In this news release, applicant depicts its mark as "CompactFlash" followed by a TM symbol. This news release reads, in part, as follows: "The concept behind CompactFlash, the world's smallest, removable mass storage device, is simple: to capture, retain and transport data, video, audio and images. ... [CompactFlash] is based on flash memory semiconductor technology."

In response, applicant has made of record 29 letters from its customers (i.e. computer equipment distributors) wherein they state essentially that they have always viewed the term COMPACTFLASH as identifying products emanating from applicant, and that moreover, when the retail customers of these distributors use the term COMPACTFLASH, said retail customers expect to receive a product from applicant.

The Examining Attorney argues that the aforementioned letters are "not relevant" because applicant "has not made any claim pursuant to Trademark Act Section 2(f)." (Examining Attorney's brief page 7). The Examining Attorney does acknowledge that these letters "might have relevance" to the issue of whether COMPACTFLASH has "acquired distinctiveness in relation to the goods." (Examining Attorney's brief page 7).

At the outset, we note that the Examining Attorney is simply incorrect in his statement that the 29 letters submitted by applicant from its customers are irrelevant to the issue at hand. While it is true that customer letters are usually submitted by an applicant in an effort to show that its mark has acquired distinctiveness through use and advertising, by the same token, there is no prohibition against submitting customer letters which tend to show that applicant's mark was inherently distinctive from the very beginning.

Given the minimal evidence made of record by the Examining Attorney, we find that these 29 letters are sufficient to, at a minimum, create doubts as to whether the term COMPACTFLASH is merely descriptive for solid state memory cartridges. It must be remembered the Examining Attorney has failed to find from the vast NEXIS database or from any other source any use of the term "compactflash" (whether depicted as one or two words) for goods identical to or even similar to applicant's goods. As previously noted, the one NEXIS excerpt (which may never have appeared in print form) does not refer to "compactflash," rather it refers to "compact flash memory products." (emphasis added). Moreover, the dictionary definitions for the terms "flash disk"; "flash memory"; and "compact" simply do not show that the term COMPACTFLASH has a recognized meaning.

When doubts exist as to whether a term is merely descriptive, it is the practice of this Board to resolve doubts in favor of the applicant and pass the mark to publication. In re Gourmet Bakers Inc., 173 USPQ 565 (TTAB 1972).

Ser No. Serial No. 74/543,923

Decision: The refusal to register is reversed.

R. F. Cissel

E. J. Seeherman

E. W. Hanak
Administrative Trademark
Judges,
Trademark Trial and
Appeal Board

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